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PCT LEGAL ADMINISTRATION

In re Application of: WEISS, Kenneth, L., et al. :
U.S. App. No.: 10/598,764 :
Filing Date: September 11, 2006 :
Attorney's Docket No.: WKI-002PAT :
For: AUTOMATED NEUROAXIS (BRAIN
AND SPINE) IMAGING WITH
ITERATIVE SCAN PRESCRIPTIONS,
ANALYSIS, RECONSTRUCTIONS,
LABELING, SURFACE
LOCALIZATION AND GUIDED
INTERVENTION : :

DECISION ON PETITIONS
(37 CFR 1.182 and 1.78(a)(3))

This decision is issued in response to applicants "Petition Under 37 C.F.R. § 1.182 To Treat Application Under 35 U.S.C. § 111" filed May 21, 2010 and the "Petition To Accept Unintentionally Delayed Claim For The Benefit Of A Prior-Filed International Application Under 37 CFR 1.78(3)" filed February 03, 2011. Applicants have paid the required petition fee and surcharge.

BACKGROUND

On March 11, 2005, applicants filed international application PCT/US2005/008311. The international application claimed a priority date of March 11, 2004, and it designated the United States. The deadline for entering the national stage in the United States and for payment of the basic national fee was thirty months from the priority date, i.e., September 11, 2006. The published international application was titled "Automated Spine Survey Iterative Scan Technique (Assist)" and it included 12 numbered claims and 19 numbered Figures.

On September 11, 2006, applicants filed materials to initiate the present application using the EFS-Web electronic filing system. The submission included a description, claims, drawings, abstract and a fee payment (including payment of the U.S. basic national fee). The specification was titled "Automated Neuroaxis (Brain and Spine) Imaging With Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization And Guided Intervention" and it included 44 numbered claims and 21 numbered figures. The submission was expressly identified by applicants as the U.S. national stage under 35 U.S.C. 371 of PCT/US05/08311.

On April 17, 2007, a filing receipt was issued that identified the application as "a 371 of PCT/US05/08311." Despite the lack of a preliminary amendment to enter the revised set of

claims filed on 11 September 2006, the filing receipt indicated that the application contained 44 claims, and applicant was charged claims fees based on the inclusion of 44 claims.

On July 28, 2009, the United States Designated/Elected Office (DO/EO/US) issued a “Notification Of Acceptance” indicating that the requirements for national stage entry under 35 U.S.C. 371(c) had been satisfied as on 21 November 2006.

On January 28, 2010, a non-final Office action was mailed. The Office action examined the revised set of 44 claims filed on September 11, 2006.

On May 21, 2010, applicants filed the “Petition Under 37 C.F.R. § 1.182 To Treat Application Under 35 U.S.C. § 111” considered herein.

On August 18, 2010, a final Office action was issued.

On February 03, 2011, applicants filed the “Petition To Accept Unintentionally Delayed Claim For The Benefit Of A Prior-Filed International Application Under 37 CFR 1.78(3)” also considered herein, with accompanying materials.

DISCUSSION

1. Petition Under 37 CFR 1.182 To Convert The Application To A Filing Under 35 U.S.C. 111(a)

As evidenced by the Electronic Acknowledgement Receipt, at the time the present application was filed, applicants clearly identified the application as the “U.S. National Stage under 35 USC 371” of PCT/US05/08311. In the present petition under 37 CFR 1.182, applicants request that the application instead “be treated as an application under 35 U.S.C. § 111 claiming priority from a previously filed PCT application.”

The petition argues that the application as filed included conflicting instructions as to whether the application was to be treated as a national stage filing under 35 U.S.C. 371 or a U.S. application filed under 35 U.S.C. 111(a), which would support treating the application under 35 U.S.C. 111(a) (see MPEP section 1893.03(a)). As applicants point out, the application as filed had a title that differed from the international application and it included a specification, claims, and drawings that were not identical to the published international application (applicants did not include with the September 11, 2006 submission a proper preliminary amendment for entry of the changes included in the revised materials). However, a review of the September 11, 2006 submission finds no specific instruction that conflicted with applicants’ express instruction, entered via the EFS-Web filing system, that the application was a national stage application filed under 35 U.S.C. 371.¹ Pursuant to the policy set forth in the MPEP, the application was therefore properly treated upon filing as a national stage filing under 35 U.S.C. 371.

¹ The failure to properly amend an international application upon national stage entry is not considered a conflicting instruction, nor is the indication that the application “claims the benefit of” the international application, as such a claim is not an effective claim of domestic priority under 35 U.S.C. 120. See MPEP section 201.11(III)(A)).

Petitions to convert an application filed as a national stage application under 35 U.S.C. 371 to a U.S. application filed under 35 U.S.C. 111(a) are not granted as a matter of course. Rather, a grantable petition must include a showing of sufficient cause to justify such conversion (i.e., the loss of patent rights or the lack of an alternative remedy). With respect to the showing of sufficient cause to justify the conversion, the present petition states that the revised specification, claims, and drawings filed on September 11, 2006 “includes substantial materials that was not found in the PCT priority application.” Applicants argue that, because the added subject matter is part of the present application file and the application has published, the failure to treat the present application as a filing under 35 U.S.C. 111(a) (and thereby accord the new subject matter disclosed herein a September 11, 2006 filing date) could bar applicants from obtaining patent protection for the new technology included in the disclosure filed on September 11, 2006.

It is noted that the claims examined herein, most of which are subject to allowance in the final Office Action mailed August 18, 2010, are the revised set of 44 claims filed on September 11, 2006 (as subsequently amended by applicants), not the original set of 12 claims contained in the international application.

Under the circumstances present here, it is determined that sufficient cause exists to justify conversion of the present application from an application filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a), with the description (34 pages), claims (5 pages including 44 numbered claims), drawings (28 pages including Figures 1-21), and abstract (1 page) filed herein on September 11, 2006 constituting the original specification and claims for the application.

Applicants’ petition under 37 CFR 1.182 requests, however, not only that the application be treated as an application filed under 35 U.S.C. 111(a), but also that the application be treated as an application “claiming priority from a previously filed PCT application.” Because the application as filed did not include an acceptable benefit claim under 35 U.S.C. 120 directed to international application PCT/US05/08311, the relief requested in the petition under 37 CFR 1.182 also requires a grantable petition under 37 CFR 1.78(a)(3) to add to the present application an unintentionally delayed benefit claim directed to the international application. Accordingly, the petition under 37 CFR 1.78(a)(3) filed on 03 February 2011 is considered below.

2. Petition Under 37 CFR 1.78(a)(3)

Applicants’ “Petition To Accept Unintentionally Delayed Claim For The Benefit Of A Prior-Filed International Application Under 37 CFR 1.78(3)” seeks acceptance of an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of international application PCT/US2005/008311, filed on March 11, 2005, as set forth in the amendment concurrently filed with the petition.

A petition under 37 CFR 1.78(a)(3) for acceptance of an unintentionally delayed benefit claim directed to a prior-filed international application designating the United States is appropriate where, as here, the later-filed application was filed on or after November 29, 2000

and an acceptable benefit claim directed to the prior-filed application was submitted after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii).²

A grantable petition under 37 CFR 1.78(a)(3) must be accompanied by the following:

- (1) the reference to the prior-filed application, as required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), unless previously submitted;
- (2) the surcharge set forth in 37 CFR 1.17(t);
- (3) A statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

With respect to item (1), above, the present petition was accompanied by a supplemental amendment to the first sentence of the specification adding an acceptable benefit claim identifying the present application as a continuation-in-part of PCT/US2005/008311, filed on March 11, 2005, which in turn claims the benefit of U.S. provisional application 60/552,332, filed March 11, 2004. The reference to the international application contained in this amendment satisfies item (1) of a grantable petition under 37 CFR 1.78(a)(3).

Applicants have submitted payment of the applicable surcharge, and the petition includes an acceptable statement of unintentional delay. Items (2) and (3) of a grantable petition under 37 CFR 1.78(a)(3) are therefore also satisfied.

Based on the above, applicants have satisfied the requirements for a grantable petition under 37 CFR 1.78(a)(3) to add to the present application a domestic benefit claim under 35 U.S.C. 120 directed to international application PCT/US2005/008311.

CONCLUSION

For the foregoing reasons, the "Petition Under 37 C.F.R. § 1.182 To Treat Application Under 35 U.S.C. § 111" filed May 21, 2010 and the "Petition To Accept Unintentionally Delayed Claim For The Benefit Of A Prior-Filed International Application Under 37 CFR 1.78(3)" filed February 03, 2011 are **GRANTED** as follows.

The present application will be treated as a U.S. application filed under 35 U.S.C. 111(a) with a filing date of September 11, 2006.

The "Notification Of Acceptance" (Form PCT/DO/EO/903) mailed on July 28, 2009 is no longer appropriate in the present application (which is no longer being treated as a filing under 35 U.S.C. 371) and is therefore **VACATED**.

² As noted above, the description filed on September 11, 2006 included a statement that the present application "claims the benefit of" PCT/US2005/008311; however, the claim did not state the relationship of the applications (i.e., continuation, continuation-in-part, or divisional), as required under 37 CFR 1.78(a)(2)(i). The benefit claim in the application as filed is therefore not an effective claim of domestic priority under 35 U.S.C. 120. See MPEP section 201.11(III)(A).

The present decision is accompanied by a corrected filing receipt identifying the application as a U.S. application filed under 35 U.S.C. 111(a) on September 11, 2006 and including a benefit claim identifying the application as a continuation-in-part of PCT/US2005/008311, which claims the benefit of U.S. provisional application 60/552,332.

The granting of the petition to accept the delayed benefit claim to the prior-filed international application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the Filing Receipt accompanying this decision on petition will include the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

Any questions concerning this decision may be directed to the undersigned. All other inquiries concerning either the examination procedures or status of the application should be directed to Group Art Unit 2624.

/RichardMRoss/

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Encl: Corrected Filing Receipt